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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,967	10/07/2003	Georgia L. Zehner	18,495	6069

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EXAMINER
COLE, ELIZABETH M

ART UNIT	PAPER NUMBER
1771	

DATE MAILED: 11/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/680,967	ZEHNER ET AL.
	Examiner	Art Unit
	Elizabeth M. Cole	1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.
2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-27 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) 1-27 is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a)☐ All b)☐ Some * c)☐ None of:
1.☐ Certified copies of the priority documents have been received.
2.☐ Certified copies of the priority documents have been received in Application No. _____.
3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

1. Claims 1-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification as originally filed does not enable one skilled in the art to make the claimed invention because it does not disclose what is meant by activation, or how activation is achieved, and the specification does not specify what force is applied to extend the materials and therefore activate the materials. .

2. Claims 1-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In independent claims 1 and 14, it is not clear what is meant by "activation". How is the liner material activated? Also, in independent claims 1 and 14, it is not clear what is meant by "adapted to", in that the structural or other changes which adapt the liner are not set forth in the claim. Also, in claims 1 and 14, it is not clear what is meant by the limitation that the elastic is non-tensioned. Does this mean that the elastic is associated with the fluid permeable layer while it is in a non-tensioned state or does it mean that the elastic is never under tension, or does it refer to the state of the elastic before "activation"? Also in claims 1 and 14, it is not clear what the claimed extensibility is in reaction to, i.e., what force is applied to extend the liner composite at least 25%? In all the independent claims, 1,14, 24 and 26, it is not clear what is meant by and "extensible, liquid impermeable outer cover material". How is the extensibility measure? What degree of extensibility is required.? In claims 2 and 17, it is not clear what is meant by the limitation "the three-dimensional configuration is a spacer element". Does this mean that the

configuration comprises a barrier element or that it forms a barrier element, and if it means it forms a barrier element, where is the barrier element in relation to the other portions of the absorbent article. The present amendment recites that the three dimensional configuration comprises a spacer element formed adjacent where the outer cover material and the non-tensioned elastic are associated. Does this imply additional structure or does it merely name a structure which is already present in the structure of claim 1? How does this claim further limit the independent claim? In claim 3 it is not clear what is meant by "associated with and superposed on... to thereby form a periphery".

3. Claims 2-13, 17-23 rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: how the spacer element is disposed in the structure of the absorbent article. The independent claims recite an impervious layer, (called the outer cover), the absorbent core and the permeable liner. The dependent claims recite a spacer element, but do not set forth the actual structure of the absorbent article.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coles, EP 650,714, alone or in the alternative, in view of Osborn III et al, U.S. Patent No. 6,287,288. Coles discloses an absorbent article which comprises a topsheet a back sheet and an absorbent core. The topsheet is permeable. The absorbent article has an elastic composite which can be

attached to either the topsheet or the backsheet. The backsheet is impermeable. The elastic composite is formed by attaching the elastic in a relaxed state, (which is equated to the claimed non-tensioned state) to another layer. See abstract. The elastic composite is then activated by stretching it to extend the other layer and activate the elastic layer. See col., 4, lines 14-26. The other layer, which has an extensibility of no more than 5% at a force of between 0.5N/cm and 5 N/cm can be a thermoplastic film, (which is impermeable). See col. 8, lines 6-15. The activated elastic composite then gathers the portions of the absorbent article to which it is attached, which corresponds to the claimed formation of the three dimensional configuration. See col. 4, lines 35-55. The elastic composite can be attached to leg portions, barrier cuffs or waist bands of the absorbent article. See col. 6, lines 9-24. While Coles does not disclose the retraction capability, since Coles teaches forming an elastic composite which can be applied to various regions of the absorbent article where elasticity is desired, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have selected the particular degree of elasticity and thus retraction capability desired in the finished article. With regard to the limitation that the other layer to which the elastic layer is bonded is extensible, it is noted the Coles discloses that the layer is generally inextensible and defines this as being able to extend 5% at a force of between 0.5 and 5 N/cm. The examiner is not able to determine whether this would anticipate the claimed degree of extensibility since the force applied is not set forth in the instant claims. Therefore, in the alternative, if the second layer of Coles is considered to be inextensible, Osborn teaches employing an extensible material as either the topsheet, the backsheet or both. See col. 25, lines 6-67. The extensible topsheet and/or backsheet enhances the comfort of the wearer of the absorbent article. Therefore, it would have been obvious to one of ordinary skill in the art to have employed an extensible topsheet or backsheet in the absorbent article of Coles, motivated by the expectation that this would enhance the comfort of the wearer of the absorbent article. The extensible backsheet would correspond to the claimed extensible, impermeable liner material which is associated with the elastic material since the elastic composite of Coles can be bonded to regions to the backsheet of the absorbent article.

6. Applicant's arguments filed 9/14/06 have been fully considered but they are not persuasive.

With regard to the 112 1st paragraph rejection, Applicant argues that instant claims do not include limitations regarding activation or extending of a liner. However, the claims refer to activation in lines 8-14 claim 1. Further, Applicant argues that the claims are enabled because what is meant by activation and how activation is achieved is discussed throughout the specification. However, the portion of the specification cited by Applicant discuses what happens after activation, (i.e., the material takes on a three-dimensional shape), but does not state what the actual steps required for activation are. Specifically, with regard to the claimed invention, since no garment structure is recited, and the material is not even referred to as a garment in the preamble of the claim, the teaching that activation occurs when being donned or while in use by a wearer does not enable one of skill in the art to make the claimed invention since the claimed invention is not a garment and cannot be worn. Applicant also argues that the specification also discusses the retraction capability differential. However, this argument is not directed to how to activate the claimed layered structure, but instead recites a further feature of the claimed invention.

With regard to the 112 2nd rejection, Applicant asserts the same arguments with regard to the rejection of "activation" under 112 2nd as were asserted with regard to the rejection under 112 1st. However, the metes and bounds of the claim are not clear because it is not clear what degree of force would have to be applied to provide activation to the claimed composite material

With regard to the limitation "adapted to", Applicant argues that the sub parts labeled as (i) and (ii) make it clear that it is the interaction of the extensible liquid impermeable outer cover material and the non-tensioned elastic and the relationship of these materials that up activation they will have a retraction capability differential of at least 10% and will attain a three dimensional configuration. However, this argument does not address how the components are adapted, i.e., how are they changed. To recite that an element is adapted implies that the element has been modified or changed beyond the element simply being present. The relationship between the two components is not an adaptation of the components, but rather sets forth their interaction. However, the claim recites that the two components are adapted to interact in a particular way upon activation, but does not set forth any structure as how the components are adapted.

With regard to non-tensioned, Applicant argues that this term is used throughout the specification. However, this does not address the merits of the rejection which states that it is not clear what is meant by non-tensioned. Applicant states that non-tensioned refers to the elastic state before activation. However, this language is not present in the claims. Further, it is noted that the elastic is still referred to as "non-tensioned" after activation when the composite liner has assumed the three-dimensional configuration.

With regard to the claimed extensibility, Applicant refers to the specification and the statement that it is desirable that the liner material be capable of extending no less than 25%. However, extensibility must be defined as the degree of extension in response to a particular force. Without knowing the force applied to extend the material the recitation of a particular percentage of extensibility is incomplete and therefore indefinite. The metes and bounds of the claim are unclear and comparison cannot be made to the prior art. For example, the primary reference employed in the art rejection, teaches "limited extensibility" which it defines as not more than 5% extension in response to a force of 0.5 and 5 N/cm. Since the instant claims do not similarly define the extensibility in terms of force, they are indefinite and cannot be compared with the prior art to determine whether or not the prior art would have the claimed degree of extensibility. The claims do not recite the degree of force applied, and therefore the claims are indefinite

With regard to the rejection omitting essential elements from the claims, the claims are required to particularly point out and distinctly claim the invention. To recite that the non-tensioned elastic is "associated" with the cover does not particularly point out and distinctly claim the invention because the structure being claimed is not clear. While the claims are understood and interpreted in light of the specification, the claims still need to recite the basic structures which are present in the claimed material.

7. With regard to the obviousness-type double patenting rejection, this rejection has been withdrawn.

8. With regard to the art rejection, Applicant argues that Coles clearly fails to teach or suggest an extensible liquid impermeable outer cover. However, Coles teaches that outer cover has an extensibility defined as being able to extend 5% at a force of between 0.5 and 5 N/cm. As set forth with regard to the 112 second paragraph rejections above, the extensibility of the claimed material is not clearly set forth. Since the Coles material is extensible to some degree it therefore meets the limitations of the independent claim. Applicant argues that Coles fails to teach an extensible liquid impermeable cover material and that the office action recognizes this fact. However, as clearly set forth in the previous action and in this action, two rejections are set forth, in view of the fact that the claims are so indefinite that their scope cannot be accurately ascertained. The first rejection relies on Coles alone, since Coles does state that the layer has an extensibility of 5% at a force of between 0.5 and 5 N/cm. Giving the instant claims their broadest reasonable interpretation and interpreting extensible as being a material which has any degree of extensibility, which is reasonable in light of the fact that the degree of extensibility is nowhere set forth, the material of Coles clearly meets this limitation. However, since the examiner is not able to determine whether the material of Coles would be considered extensible as the term is used in the instant claims, an alternative rejection is also set forth employing the Osborne reference.

9. Applicant argues that there is no motivation to make the combination of Coles and Osborn. However, Osborn teaches employing an extensible material as either the topsheet, the backsheet or both. See col. 25, lines 6-67. The extensible topsheet and/or backsheet enhances the comfort of the wearer of the absorbent article. Therefore, it would have been obvious to one of ordinary skill in the art to have employed an extensible topsheet or backsheet in the absorbent

article of Coles, motivated by the expectation that this would enhance the comfort of the wearer of the absorbent article.

10. Applicant argues that Coles teaches away from the claimed invention because Coles teaches an extensibility of no more than 5% while the instant invention requires an extensibility of no less than 10%. However, as set forth above, the extensibility of Coles and the instantly claimed material cannot be compared until the extensibility of the instant material is defined in terms of the force applied. Otherwise, there is no real way to compare the two values. That is why two different rejections are set forth.

11. Applicant argues that instant claims require that the invention clearly defines extensible to mean capable of extending no less than 10%. Applicant refers to page 5 of the specification in support of this. However, page 5 merely defines extensibility as a difference between the extended length minus the initial length, divided by the initial length times 100. This does not state what force is applied. Similarly, the test methods noted at page 14 do not state what force is applied. Therefore, the specification and claims do not define what is meant by extending no less than 10% since they do not define the force which is employed to extend the material.

With regard to the combination of Coles and Osborn, Applicant argues that the extensible layer of Osborn could not be substituted for the inextensible layer of Coles because Coles requires the less extensible layer to be permanently elongated so that pleats are formed. In response to this, first is noted that Coles does not teach an inextensible layer, but rather teaches a layer which has a certain degree of extensibility in response to a particular amount of force. The instant claims do not define the extensibility in terms of how much force is applied, and therefore, meaningful comparison between the two is not possible. However, it is inaccurate to call the layer set forth in Coles inextensible, when in fact, Coles teaches that the layer has some degree of extensibility. Further, with regard to the argument that an extensible layer as taught by Osborn could not be used in the structure of Coles, Coles merely requires that there be a difference in extensibility of the two layers so that the less extensible layer is extended so as to be permanently elongated. Coles does not require a completely inextensible layer, but a relatively inextensible layer. Therefore, the extensible layer of Osborn could be combined with the Coles structure in order to improve the comfort of the wearer of the absorbent article, while still maintaining the ability of the extensible layer to be extended to a degree that it is permanently extended in order to form pleats, as long as a difference in extensibility was maintained.

Applicant asserts that Coles differs from the claimed invention by only the single difference of using an inextensible rather than an extensible fluid impermeable material. However, as set forth above, Coles does not teach an absolutely inextensible material, but rather teaches one which has a particular degree of extensibility. Since the instant claims are indefinite due to their incompleteness since the extensibility is not set forth in terms of the force applied, it is not clear whether the layer of Coles is extensible as the instant claims intend to use the word. However, it is also clear that the material of Coles is not inextensible in any absolute sense and that it is impossible to fully compare the claimed invention to prior art due to the indefiniteness of the claims. Finally, even if the material of Coles does not teach a layer which has the claimed extensibility, Osborn provides a motivation for bonding an elastic layer to a more extensible layer in order to improve the fit and comfort of garments which comprise the composite material.

As long as there was a difference in the extensibility of the two materials, a gathered material would still be formed upon elongation of the composite material as taught by Coles.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth M. Cole whose telephone number is (571) 272-1475. The examiner may be reached between 6:30 AM and 6:00 PM Monday through Wednesday, and 6:30 AM and 2 PM on Thursday.

Mr. Terrel Morris, the examiner's supervisor, may be reached at (571) 272-1478.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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